

REMARKS

Reconsideration of this application, as amended, is respectfully requested.

Claims 1-52 are pending. Claims 1-52 stand rejected.

Claims 1, 19, 31, 38, 39, 43, 45-48, and 50-51 have been amended. No claims have been canceled. No claims have been added. Support for the amendments is found in the specification, the drawings, and in the claims as originally filed. Applicant submits that the amendments do not add new matter.

Applicant reserves all rights with respect to the applicability of the Doctrine of Equivalents.

Claims 1, 9-10, 12-15, 19, 24-25, 27-31, 33-34, 37-38, 41, and 44 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,490,217 to Wang (“Wang”).

Applicant has amended claim 1 to read as follows:

A method comprising:

- representing a first collection of media objects including one or more first groups of electronic documents by a first graphical content having one or more first thumbnails on a first sheet representing the media objects wherein the first sheet is a cover sheet that provides access to the first collection of the media objects, wherein the cover sheet is a non-electronic medium;

- scanning a first identifier on the first sheet to identify the first collection of media objects using a scanner configured to scan images; and

- adding one or more other media objects to the first collection of media objects that has been identified by the scanning the first sheet to create a second collection of media objects including one or more second groups of electronic documents; and

- re-marking the first sheet that includes printing a second graphical content having one or more second thumbnails representing the second collection of media objects onto the first sheet using a printer, such that the second graphical content is presented on the first sheet in a non-electronic form, wherein the re-marked first sheet including the second graphical content in the non-electronic form provides access to the second collection of the media objects.

(emphasis added)

Wang discloses an automatic document handling system. More specifically, Wang discloses generating to each document a machine-readable code which contains content and identifying information about the document, information about the document format, and processing instructions. (Abstract). In particular, Wang discloses the following:

A patient medical progress chart 22 (FIG. 7) may be generated by the system of the present invention containing a two-dimensional machine readable image code form 16, which machine readable image code will initially contain information about the form type, patients historical information (name, address, social security number, billing rate, insurance information and the like), number of pages of the record and the like. After the machine readable image code containing form 22 is created the user thereof (i.e., a doctor) can record information, in typed form or even handwritten, thereon which subsequently may be rescanned by the system of the present invention which system will update the computer file on the system and modify the machine readable image code 16 to reflect the addition of new information to that patient's file. When a patient visits a doctor's office or a hospital, a machine readable image code containing medical ID issued to the patient will be scanned, then the present invention system will automatically retrieve the patient's file and display and/or print same.

(Wang, col. 5, lines 38-56)(emphasis added)

As set forth above, Wang merely discloses generating to each document a machine-readable code. In contrast, amended claim 1 refers to a graphical content having one or more thumbnails that represents one or more groups of electronic documents. Wang fails to disclose representing a first collection of media objects including one or more first groups of electronic documents by a first graphical content having one or more first thumbnails on a first sheet, as recited in amended claim 1.

Moreover, Wang merely discloses modifying the code that contains information about the single document. In contrast, amended claim 1 refers to printing one or more second thumbnails representing one or more groups of electronic documents. Wang fails to disclose re-marking the first sheet that includes printing a second graphical content having one or more second thumbnails representing the second collection of media objects onto the first sheet using a printer, such that the second graphical content is presented on the first sheet in a non-electronic

form, wherein the re-marked first sheet including the second graphical content in the non-electronic form provides access to the second collection of the media objects, as recited in amended claim 1.

Because Wang fails to disclose all limitations of amended claim 1, applicant respectfully submits that claim 1, as amended, is not anticipated by Wang under 35 U.S.C. §102(b).

For similar reasons, applicant respectfully submits that claims 9-10, 12-15, 19, 24-25, 27-31, 33-34, 37-38, 41, and 44 are not anticipated by Wang under 35 U.S.C. §102(b).

Claim 46 stands rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Publication No. 2002/0052888 to Sellen et al. (“Sellen”).

Amended claim 46 read, in part, as follows: “performing, using a peripheral device, an erasing operation on the scanned portion of the document that includes removing the content in the non-electronic form directly from the portion of the document using the peripheral device; scanning, using the scanner configured to scan the images, the portion of the document that has been subjected to the erasing operation to obtain second scanned data; and determining whether the non-electronic medium is erasable so that the content in the non-electronic form is removable directly from the non-electronic document based on the first scanned data and the second scanned data.” (emphasis added).

Sellen discloses synchronizing the stored records and the printed records based on a version identifier. More specifically, Sellen discloses comparing the paper version of the document and the stored version to produce a revised version incorporating changes made to the stored version. (paragraphs [0036]-[0037]). Thus, Sellen discloses making changes to the stored version. In contrast, amended claim 46 refers to removing the content in the non-electronic form directly from the portion of the non-electronic document using the peripheral device.

Further, Sellen discloses comparing the stored content with the scanned content to determine whether the changes need to be made to the stored content (Figure 5, operations 72-82). In contrast, amended claim 46 refers to determining whether the content in the non-electronic form is removable directly from the non-electronic document based on the first scanned data and the second scanned data.

Because Sellen fails to disclose all limitations of amended claim 46, applicant respectfully submits that claim 46, as amended, is not anticipated by Sellen under 35 U.S.C. §102(b).

Claims 2-4, 6-7, 20-22, 32, 36, 39-40, 43, 45, 48, and 50-52 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Wang in view of U.S. Patent No. 6,432,518 to Torii et al. (“Torii”).

Torii, in contrast, discloses an erasable recording material.

Furthermore, even if Torii and Wang were combined, such a combination would still lack representing a first collection of media objects including one or more first groups of electronic documents by a first graphical content having one or more first thumbnails on a first sheet, as recited in amended claim 1.

Moreover, even if Torii and Wang were combined, such a combination would still lack re-marking the first sheet that includes printing a second graphical content having one or more second thumbnails representing the second collection of media objects onto the first sheet using a printer, such that the second graphical content is presented on the first sheet in a non-electronic form, wherein the re-marked first sheet including the second graphical content in the non-electronic form provides access to the second collection of the media objects, as recited in amended claim 1.

Given that claims 2-4, 6-7, 20-22, 32, 36, 39-40, 43, 45, 48, and 50-52 contain the limitations that are similar to those limitations discussed above, applicant respectfully submits that claims 2-4, 6-7, 20-22, 32, 36, 39-40, 43, 45, 48, and 50-52 are not obvious under 35 U.S.C. §103(a) over Wang in view of Torii.

Claim 42 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Wang in view of Torii and further in view of U.S. Patent No. 6,373,575 to Takayama (“Takayama”).

Takayama, in contrast, discloses a paper classification apparatus.

Furthermore, even if Wang, Torii, and Takayama were combined, such a combination would still lack a scanner to scan a sheet representing a first collection of media objects including one or more first groups of electronic documents by a first graphical content having one or more first thumbnails on the sheet in a non-electronic form; a processing unit to modify the first collection of media objects by adding one or more pages of the one or more other media objects to the first collection of media objects to create a second collection of media objects including one or more second groups of electronic documents, wherein the first collection of media objects has been identified by the scanning a first identifier on the first sheet using the scanner configured to scan the images; a marking unit to re-mark the sheet that includes a printer to print a new identifier and new graphic content having one or more second thumbnails representing the second collection of media objects onto the sheet in a non-electronic form, wherein the re-marked first sheet including the new identifier and the new graphic content in the non-electronic form provides access to the second collection of the media objects, as recited in amended claim 39.

Given that claim 42 depends from amended claim 39, and adds additional limitations, applicant respectfully submits that claim 42, as amended, is not obvious under 35 U.S.C. §103(a) over Wang in view of Torii and further in view of Takayama.

Claims 5, 8, and 23 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Wang in view of Torii and in further view of U.S. Patent No. 5,764,368 to Shibaki (“Shibaki”).

Shibaki, in contrast, discloses an image processing apparatus using retrieval sheets capable of recording additional retrieval information.

Furthermore, even if Wang, Torii, and Shibaki were combined, such a combination would still lack representing a first collection of media objects including one or more first groups of electronic documents by a first graphical content having one or more first thumbnails on a first sheet, as recited in amended claim 1.

Moreover, even if Shibaki, Torii and Wang were combined, such a combination would still lack re-marking the first sheet that includes printing a second graphical content having one or more second thumbnails representing the second collection of media objects onto the first sheet using a printer, such that the second graphical content is presented on the first sheet in a non-electronic form, wherein the re-marked first sheet including the second graphical content in the non-electronic form provides access to the second collection of the media objects, as recited in amended claim 1.

Given that claims 5, 8 and 23 contain limitations that are similar to those limitations set forth above with respect to amended claim 1, applicant respectfully submits that claims 5, 8 and 23 are not obvious under 35 U.S.C. §103(a) over Wang in view of Torii and in further view of Shibaki.

Claims 11, 26, and 35 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Wang in view of U.S. Patent No. 3,713,148 to Cardullo et al. (“Cardullo”).

Cardullo, in contrast, discloses a transponder.

Furthermore, even if Wang, Torii, and Cardullo were combined, such a combination would still lack representing a first collection of media objects including one or more first groups

of electronic documents by a first graphical content having one or more first thumbnails on a first sheet, as recited in amended claim 1.

Moreover, even if Shibaki, Torii and Cardullo were combined, such a combination would still lack re-marking the first sheet that includes printing a second graphical content having one or more second thumbnails representing the second collection of media objects onto the first sheet using a printer, such that the second graphical content is presented on the first sheet in a non-electronic form, wherein the re-marked first sheet including the second graphical content in the non-electronic form provides access to the second collection of the media objects, as recited in amended claim 1.

Given that claims 11, 26, and 35 contain the limitations that are similar to those limitations discussed with respect to amended claim 1, applicant respectfully submits that claims 11, 26, and 35 are not obvious under 35 U.S.C. §103(a) over Wang in view of Cardullo.

Claims 16-18 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Wang in view of U.S. Patent No. 6,260,063 to Ludtke et al. (“Ludtke”).

Ludke, in contrast, discloses using object lists and object entries.

Furthermore, even if Wang, Torii, and Ludke were combined, such a combination would still lack representing a first collection of media objects including one or more first groups of electronic documents by a first graphical content having one or more first thumbnails on a first sheet, as recited in amended claim 1.

Moreover, even if Shibaki, Torii and Ludke were combined, such a combination would still lack re-marking the first sheet that includes printing a second graphical content having one or more second thumbnails representing the second collection of media objects onto the first sheet using a printer, such that the second graphical content is presented on the first sheet in a non-electronic form, wherein the re-marked first sheet including the second graphical content in

the non-electronic form provides access to the second collection of the media objects, as recited in amended claim 1.

Given that claims 16-18 contain limitations that are similar to those limitations discussed with respect to amended claim 1, applicants respectfully submit that claims 16-18 are not obvious under 35 U.S.C. §103(a) over Wang in view of Ludtke.

Claim 47 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Wang in view of U.S. Publication No. 2002/0064113 to Geeslin (“Geeslin”).

Amended claim 47 includes detecting a writable mark when scanning a re-writable paper, wherein the writable mark includes a shape placed on the re-writable paper in a non-electronic form, wherein the re-writable paper is a non-electronic medium, wherein the writable mark indicates that the re-writable paper is non-rewritable; and preventing modification to the re-writable paper that includes preventing from printing that includes forming images, by a peripheral device, a content in the non-electronic form on the re-writable paper that is the non-electronic medium in response to detecting the writable mark through the scanning the re-writable paper by a scanner that is configured to scan the images.

Wang discloses generating to each document a machine-readable code which contains content and identifying information about the document, information about the document format, and processing instructions (Abstract). Wang fails to disclose a writable mark that indicates that the re-writable paper is non-rewritable, as recited in amended claim 1. Furthermore, Wang fails to disclose preventing from printing that includes forming images, by a peripheral device, a content in the non-electronic form on the re-writable paper that is the non-electronic medium in response to detecting the writable mark through the scanning the re-writable paper by a scanner that is configured to scan the images, as recited in amended claim 47.

Geeslin, in contrast, discloses setting a protection state for the optical disc media. In contrast, amended claim 47 refers to detecting a writable mark when scanning a re-writable paper, wherein the writable mark includes a shape placed on the re-writable paper in a non-electronic form, wherein the re-writable paper is a non-electronic medium, wherein the writable mark indicates that the re-writable paper is non-rewritable; and preventing modification to the re-writable paper that includes preventing from printing that includes forming images, by a peripheral device, a content in the non-electronic form on the re-writable paper that is the non-electronic medium in response to detecting the writable mark through the scanning the re-writable paper by a scanner that is configured to scan the images, as recited in amended claim 47.

Torii similarly fails to disclose the above limitations of amended claim 47.

Furthermore, even if Torii, Wang, and Geeslin were combined, such a combination would still lack detecting a writable mark when scanning a re-writable paper, wherein the writable mark includes a shape placed on the re-writable paper in a non-electronic form, wherein the re-writable paper is a non-electronic medium, wherein the writable mark indicates that the re-writable paper is non-rewritable; and preventing modification to the re-writable paper that includes preventing from printing that includes forming images, by a peripheral device, a content in the non-electronic form on the re-writable paper that is the non-electronic medium in response to detecting the writable mark through the scanning the re-writable paper by a scanner that is configured to scan the images, as recited in amended claim 47.

Therefore, applicant respectfully submits that claim 47, as amended, is not obvious under 35 U.S.C. §103(a) over Wang in view of Geeslin.

Claim 49 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Wang in view of Torii and in further view of Sellen.

Sellen, in contrast, discloses an electronic record storage.

Furthermore, even if Sellen, Torii, and Wang were combined, such a combination would still lack representing a first collection of media objects including one or more first groups of electronic documents on a sheet using an image including one or more first thumbnails, wherein the sheet is a cover sheet that provides access to the first collection of the media objects, and wherein the cover sheet is a non-electronic medium; and re-marking the sheet that includes printing a second graphical content having one or more second thumbnails to represent the second collection of media objects that includes one or more second groups of electronic documents, such that the second graphical content is presented on the sheet in a non-electronic form using a printer, wherein the re-marked sheet including the second graphical content in the non-electronic form provides access to the second collection of the media objects, as recited in amended claim 48.

Given that claim 49 depends from amended claim 48 and adds additional limitations, applicant respectfully submits that claim 49 is not obvious under 35 U.S.C. §103(a) over Wang in view of Torii and further in view of Sellen.

It is respectfully submitted that in view of the amendments and arguments set forth herein, the applicable rejections and objections have been overcome. If the Examiner believes a telephone conference would expedite in the prosecution of the present application, the Examiner is invited to call the undersigned at (408) 720-8300.

If there are any additional charges, please charge Deposit Account No. 022666.

Respectfully submitted,
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